

REMARKS

Claims 1-26, 144-159 and 192 are presently pending in the application. Claims 20-26 and 153-159 have been withdrawn from consideration. Claims 27-143 and 160-191 have been canceled in a good faith effort to move prosecution forward toward allowance. With respect to the claims presently being considered by the Office, namely claims 1-19, 144-152 and 192, an obviousness issue was raised in the December 9, 2008 Office Action under 35 U.S.C. §103(a) based on U.S. Patent No. 6,187,005 (Brace et al.) (hereinafter referred to as "the Brace et al. reference") and U.S. Patent No. 4,887,595 (Heinig et al.) (hereinafter referred to as "the Heinig et al. reference"). This response addresses every substantive issue raised in the Office Action.

I. REJECTION OF CLAIMS UNDER 35 U.S.C. §103(a) IS TREATED.

Regarding the obviousness issue raised by the Office under 35 U.S.C. §103(a), and the Office's prior concerns about the number of claims being prosecuted, applicant has canceled all but forty-three (43) claims, and notes the thousands of dollars previously paid in patent claim filing fees. Applicant further notes the following reasons why the remaining claims are patentable, and respectfully asserts that the final rejection can reasonably be withdrawn in favor of a Notice of Allowance.

Applicant's counsel has carefully studied the reasoning for the rejection provided in the Office Action, together with the Brace et al. reference and the Heinig et al. reference relied upon.

With respect to independent claims 1 and 144, applicant respectfully submits that there is a teaching away from using the two references together. More specifically, the device disclosed in the Brace et al. reference is directed to a polyaxial screw and clamp mechanism that has a rod locking mechanism that is separate and distinct from the polyaxial screw. In other words, the locking mechanism in the Brace et al. reference is located at a different location than the screw, such that the screw does not provide any locking or clamping force.

On the other hand, the device disclosed in the Heinig et al. reference (illustrated best in FIGS. 6 and 7) uses a bone screw and locking nut to provide a locking force to secure the elongate rod to the clamp. However, if these two (2) references were combined, it would result in two bone screws being used to lock a single clamp to a pedicle of the spine - i.e., one bone screw with polyaxial capability as disclosed in the Brace et al. reference and one bone screw and nut combination used to lock the rod in place as disclosed in the Heinig et al. reference. Such a result (i.e., two screws located in a single pedicle to lock a single clamp) is not advantageous for use with the spine. There is simply no room or not enough bone for two (2) bone screws to be inserted into the same general location to lock a single clamp to the pedicle of the

spine. Thus, combining the two references relied upon, as suggested in the Office Action, renders any resulting device unworkable. For the above reasons, there is a teaching away such that the two references cannot be used to reject applicant's claims and a finding of the same is respectfully requested.

Dependant claims 2-19 and 192 depend from claim 1 or a claim depending from claim 1, and are therefore believed to be allowable for at least the reasons given in support of claim 1. Applicant further requests separate consideration by the Office of these dependent claims on their own merits, since some or all of said dependent claims are believed to be allowable regardless of whether their base independent claim is allowable.

Regarding independent claim 144, the Office Action suggested that the Brace et al. reference in combination with the Heinig et al. reference disclose all of the claimed elements of independent claim 144 and on that basis rejected those claims as being obvious. Applicant respectfully traverses that rejection because those references do not disclose, teach or suggest the structural relationship required by independent claim 144. More specifically, the references do not disclose, teach or suggest a first through-passage and a second through passage formed in a connecting member, wherein a female-threaded recess of a fastening member is disposed in alignment with a second through-passage of the connecting member when the male-tapered external portion of the fastening member is disposed in engagement with the sidewalls defining the female-

tapered first through-passage of the connecting member. Independent claim 144 claims a structural relationship between the connecting member and the fastening member that is not disclosed, taught or suggested by the Brace et al. reference in combination with the Heinig et al. reference.

The alignment claimed by applicant allows a fastener to pass through the second through-passage and into the female-threaded recess of the fastening member causing a clamping action to occur. Conversely, the Brace et al. reference discloses, teaches and suggests a single through-passage (instead of two through-passages) formed in the connecting member that functions to permit the bone screw or fastener 14 to move in a polyaxial manner prior to being locked (see column 3, lines 41-53). The Brace et al. single through-passage does not permit any clamping of the rod or elongate member. Further, adding the disclosure of the Heinig et al. reference does not make up for this failure. Accordingly, claim 144 is believed to be allowable for at least the reasons expressed above.

Dependant claims 145-152 depend from claim 144 or a claim depending from claim 144, and are therefore believed to be allowable for at least the reasons given in support of claim 144. Applicant further requests separate consideration by the Office of these dependent claims on their own merits, since some or all of said dependent claims are believed to be allowable regardless of whether their base independent claim is allowable.

II. CONCLUSION.

In view of the foregoing, applicant believes that claims 1-26, 144-159 and 192 are all allowable and the same is respectfully requested. If any impediment to the allowance of these claims remains after entry of this Amendment, and such impediment could be alleviated during a telephone interview, the Examiner is invited to initiate the same.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0836.

DATED this 9th day of February, 2009.

Respectfully submitted,



Karl R. Cannon
Attorney Registration No. 36,468
Attorney for Applicant

Clayton, Howarth & Cannon, P.C.
P.O. Box 1909
Sandy, UT 84091
Telephone: (801) 255-5335
Facsimile: (801) 255-5338

KRC/TJE

S:\CHC Files\T 9--\T97--\T9742\Response I.wpd